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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,289

10/28/2003

Donald F. DePalma

CRD-5052

3943

27777

7590

01/26/2005

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/695,289	Applicant(s) DEPALMA, DONALD F.	
	Examiner Suzette J Gherbi	Art Unit 3738	

-- Th MAILING DATE of this c mmunication app ars on the cover sheet with the correspond nc addr ss --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claims 8-10 (the second number 8) been renumbered 9-11.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The phrase "connected to an inner portion" in claim 1 is a relative phrase which renders the claim indefinite. This phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. In

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particular it is unclear as to what inner portion the claim is referring to, i.e. the inner portion of the cover? An inner portion of what? The claim should be absolutely clear with no guessing involved as to what is being claimed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Banas et al. 6,383,214. Banas et al. discloses the invention as claimed noting figures 5 and 6 comprising: a prosthesis with a fluid flow path ; a cover (26) and a support assembly (22) *supporting the cover (functional language)* ; the support assembly including one or more support structures where each support structure includes an outer portion (this is the outside of the support structure) matingly connected to an inner portion (it is connected to the inner portion of the cover) wherein the cover is sandwiched between the outer and inner portions (the term sandwich is defined as to insert between two other things there for col. 7, lines 60-67 disclose that the first and second flexible layers (24, 26) are fused together through the openings located between the struts of the stent; therefore the cover is “sandwiched” between the inner and outer portions).

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6. Claims 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Wallace et al. 6;254,628. Wallace et al. discloses the invention as currently claimed noting figure 25 comprising: a cover (1) supported by a support assembly (85) wherein the support assembly has a plurality of support structures (86, 87) wherein the cover is looped around the supports structure and closed with a connector (83).

7. Claims 11 is rejected under 35 U.S.C. 102(e) as being anticipated by Gunderson 2004/0204749. Gunderson discloses the invention as currently claimed noting figures 8, 1-2 comprising: a cover (52); a support assembly supporting the cover, the support assembly including one or more support structures (distal and proximally located see [0033]; each support structure comprising a ring with a plurality of protrusions (14) disposed about the circumference of the ring; wherein the protrusions engage the cover to anchor the support structure to the cover

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 4-5 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Banas et al. 6,383,214 in view of Banas et al. 5,749,880. Banas et al. '214 have been disclosed above however Banas et al. does not specify that the metal is Nitinol. Banas et al. '880 teaches that Nitinol (col. 6, lines 14-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the support structure of '214 Banas from Nitinol because Nitinol is well known in the art for its elastic properties and capable of self-expansion.

#### ***Allowable Subject Matter***

10. Claims 6-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

11. Claims 6-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

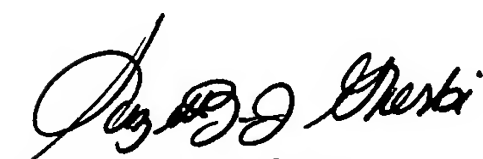
12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shull et al. 6,143,022 ; Nolting 6,099,559 ; Bynon et al. 5,667,523 ; Schatz 5,902,332 show related material.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 571-272-4751.

14. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Suzette J-J Gherbi  
24 January 2005